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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/683,878	10/10/2003	Duane R. Pillar	061300-0361	7841
26371	7590	10/20/2006		
FOLEY & LARDNER LLP 777 EAST WISCONSIN AVENUE MILWAUKEE, WI 53202-5306			EXAMINER BROADHEAD, BRIAN J	
			ART UNIT	PAPER NUMBER
			3661	

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/683,878

Applicant(s)

PILLAR ET AL.

Examiner

Brian J. Broadhead

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 17-23, 25, 26 and 28-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-23, 25, 26 and 28-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. Claims 1-13, 32, 33, 23, 25, 26, 28, 29, 30, 31, 35, and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite the limitation of adjusting the at least one output device while in proximity to the at least one output device. The specification does not disclose the requirement that the handheld needs to be in proximity to the output device and is totally silent as to how it would be determined if the handheld is in proximity to the output device.

2. Claims 1-13, 32, 33, 23, 25, 26, 28, 29, 30, 31, 35, and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims recite the limitation of adjusting the at least one output device while in proximity to the at least one output device. The specification does not disclose the requirement that the handheld needs to be in proximity to the output device and is totally silent as to how it would be determined if the handheld is in proximity to the output device.

***Claim Rejections - 35 USC § 102***

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States:

2. Claims 28, 35, and 36 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Kempen et al., 6421593. Applicant admits the relevant portions of this reference qualify as prior art under 35 U.S.C. 102(b). The language of being in proximity to the output device is functional language that the admitted disclosure is capable of. The test program corresponds to the admitted art's control of the input output devices. These input output device include engine controls and transmission so vehicle movement would be controllable by the PDA of the admitted prior art.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 7-13, 23, 25, 29-31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art of Kempen et al., 6421593, in view of Seibel, 20040203974.

5. Kempen et al. clearly discloses all the limitations except for the computer being a PDA; the wireless communications is encrypted; the PDA has a touch screen; the wireless range is one mile or 1000 feet; the manipulation of the input and output devices

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admitted in Kempen et al. reads on the test program; and the location of the PDA while carrying out the tests is functional language that the admitted prior art is capable of.

Seibel teaches using a PDA in place of a computer or laptop in paragraph 11. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the PDA in place of the laptop because it is a design choice. The advantages and limitations of a PDA over a laptop or PC are readily evident in the art. Kempen et al. and Seibel do not disclose the PDA has a touch screen; and the wireless range is one mile or 1000 feet. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a PDA with a touch screen and have wireless range of one mile or 1000 feet because it is a design choice. Most PDA have touch screens, and the most common types of wireless communication with a PDA is 802.11 and depending on conditions can reach up to a mile. PDA's are more portable than a laptop and would be easier to transport. They generally have a better battery life and are really just a small version of a PC.

6. Claims 5, 6, 14, 15, 17-22, and 26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kempen et al., 6421593, in view of Seibel, 20040203974 as applied to claims 1-4, 7-13, 23, 25, and 29-31 above, and further in view of Kaman, 5844473.

7. Kempen et al. and Seibel disclose the limitations as set forth above. They do not disclose the PDA can be connected to a fleet of vehicles; and all the various report types. Kaman teaches connecting to a fleet of vehicle to generate reports on lines 63-67, on column 2, and lines 1-5, on column 3. All of the various maintenance and usage reports are a design choice within the ordinary skill of one in the art and provide no

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unexpected results. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Kaman in the invention of Siebel and Kempen et al. because such modification would provide reliable monitoring of vehicle usage and as Kaman discloses on lines 10-14, on column 1, "the need to collect operational information on mobile vehicles is well known. Recommended vehicular maintenance procedures are typically tied to vehicular usage. The more a vehicle is used the more frequently the vehicle must be serviced."

8. Claims 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kempen et al., 6421593, in view of Lastinger et al., 2005/0060246.

9. Kempen et al. disclose the limitations as set forth above. They do not disclose the PDA is configured to receive a radio frequency signal from the cargo stored in the storage compartment that includes characteristics of the cargo; and generating a report based on the characteristics of the cargo. Lastinger et al. teach of a portable reader for receiving radio signals from the cargo including characteristics and generating a report based on the signals in paragraphs 28, 38, 47, 48, 68 and 71-73. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the invention of Lastinger et al. in the invention of Kempen et al. because such modification would allow the PDA of Kempen et al. to perform more diagnostics. Lastinger provides a way to gain more operational data such as weight distribution to make sure the vehicle is performing efficiently.

10. Claims 32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kempen et al., 6421593, in view of Seibel, 20040203974, Kaman, 5844473, as

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applied to claims 1-4, 7-13, 23, 25, 29-31, 5, 6, 14,15, 17-22, and 26 above, and further in view of Rothert et al., 6141610.

11. Kempen et al., Seibel, and Kamen disclose the limitations as set forth above. They do not disclose generating a customer invoice based on I/O status information. Rothert et al. teach generating a customer invoice based on I/O status information in figure 6. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of Rothert in the invention of Kempen et al., Seibel, and Kamen because such modification would provide for automated billing for a rental fleet without entering information manually as disclosed on lines 37-55, on column 2, of Rothert et al.

12. Applicant's arguments filed 8-1-06 have been fully considered but they are not persuasive. The addition of the limitation relating to location of the PDA does not overcome the prior art since it is functional language that the prior art is fully capable of performing. The argument that Kempen does not appear to motivate, teach, or suggest the need for or any benefit of a PDA is not understood since in the IDS filed 11/25/2005 this information is clearly admitted.

13. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

14. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kamen discloses "the need to collect operational information on mobile vehicles is well known. Recommended vehicular maintenance procedures are typically tied to vehicular usage. The more a vehicle is used the more frequently the vehicle must be serviced." This provides a motivation to use the reports of Kaman with the diagnostics of Kempen and Siebel.

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Broadhead whose telephone number is 571-272-6957. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on 571-272-6956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
BJB

  
THOMAS BLACK  
SUPERVISORY PATENT EXAMINER